

## PATENT

## C. REMARKS

Status of the Claims

Claims 1-5, 7-13, 15-21, and 23-27 are currently present in the Application and stand rejected. Claims 1, 11, 19, and 27 are independent claims. In this Response, claims 15 and 16 have been amended, and no claims have been cancelled or added.

Claim Objections

Claims 15 and 16 were objected to because they depended upon a cancelled claim. These claims have been amended so that the claims depend upon independent claim 11. Applicants, therefore, respectfully request the withdrawal of the objection.

Claim Rejections - Alleged Obviousness Under 35 U.S.C. § 103

The Office Action rejects Applicants independent method claims 1 and 27 and dependent claim 5 under 35 U.S.C. § 103 as allegedly being obvious, and therefore unpatentable, over U.S. Patent No. 6,351,813 to Mooney et al. (hereinafter "Mooney") in view of U.S. Patent No. 6,711,679 to Guski et al. (hereinafter "Guski"). The Office Action rejects Applicants other independent claims, 11 and 19, as being obvious, and therefore unpatentable, over Mooney in view of Guski in further view of U.S. Patent No. 6,668,321 to Nendell et al. (hereinafter "Nendell"). Applicants respectfully traverse the rejections.

The rejections of Applicants claims cannot stand for at least two reasons. First, each of the rejections relies upon the Guski patent. The Guski patent and the instant application were, at the time that the invention was made, each owned by, or subject to an obligation of assignment to the same person. In particular, both the Guski patent and the instant application

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were, at the time that the invention was made, assigned to the International Business Machines Corporation. 35 U.S.C. § 103(c) states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The instant application was filed on or after the filing date of the Guski patent and before the issuance date of the Guski patent. Therefore, the Guski patent qualifies as prior art under 35 U.S.C. § 102(e). The instant application and the Guski patent were commonly owned or subject to an obligation of assignment to the same person at the time the invention was made. Therefore, the Guski patent cannot be used in a 35 U.S.C. § 103 rejection to preclude patentability. As such, the rejection is improper and should be withdrawn.

Because Guski cannot be used in a 35 U.S.C. § 103 rejection to preclude patentability, the rejection of claims 1-5, 7-13, 15-21, and 23-27 is therefore traversed. Applicants note that the Guski patent was used in support of the rejections of all of Applicants' currently remaining claims. Consequently, all of Applicants' remaining claims are allowable over the prior art.

Second, Applicants note that the Office Action contends that the Mooney reference teaches Applicants' claimed limitation of "transmitting the password in a secure channel to use for encrypting/decrypting the data" (Office Action, Para. 4, citing Mooney). Interestingly, the Office Action does not cite a section of Mooney in support of Mooney actually teaching

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transmitting a password in a secure channel. Also, the Office Action admits that Mooney does not teach "sending a request from a first computer to a second computer prior to establishing a secure connection." (Office Action, Para. 4). Those of skill in the art would realize that a traditional secure channel, such as a Secure Socket Layer (SSL) channel, is established by first sending a request from the first computer to the second computer over a non-secure channel (i.e., a request that is sent before the secure channel is established). Consequently, either Mooney is not sending the password over a secure channel, or Mooney is establishing a secure channel in some other manner. A review of Mooney reveals that Mooney does not teach or suggest sending the password over a secure channel, as taught and claimed by Applicants. Instead, Mooney teaches using a password to encrypt/decrypt files that is stored on a "smart card." At col. 3, lines 42-26, Mooney teaches:

The encrypted files can only be decrypted using the electronic key contained on the unique personalized ITAI prepared smart card. The electronic key provides a means of duplicating and transporting files to other users without compromising the data integrity.

Mooney further describes how the smart card that contains the password is prepared. At col. 4, line 66 to col. 5, line 9, Mooney teaches:

Prior to a user receiving the system, a smart card preparation program is run by ITAI to (1) initialize the smart card access codes, (2) create necessary smart card files including session key files, level files and data files, (3) initialize those files with level key data, default questions, and the session key as described below it [sic: in] the "Access Code Mechanism" section, and (4) initialize the smart card database (SCDB) described below in the "Smart Card Database" section. Upon receiving the system, the

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user changes the default questions and answers to something only that the person can answer."

Importantly, throughout the Mooney reference, Mooney consistently describes the password being stored and retrieved from a smart card. Smart cards are well known in the art as being a hardware component that stores data in a secure fashion. Contrary to assertions made in the Office Action, Mooney teaches using passwords stored on smart cards and does not teach or suggest sending passwords over a secure channel from one computer system to another computer system, as taught and claimed by Applicants.

Each of Applicants' independent claims include the limitation of *sending a password from a first computer system to a second computer system across a secure connection*. Therefore, as explained above, Mooney is ineffective in supporting a rejection of any of Applicants' independent claims. Furthermore, each of Applicants' independent claims were rejected under 35 U.S.C. § 103 using Guski in support of the rejections. As described above, Guski is an improper 103 reference because it qualifies as 102(e) art and the Guski patent and the instant application were commonly owned at the time of the instant invention. Therefore, each of Applicants' independent claims is allowable because, (1) Mooney does not teach or suggest a limitation found in each of Applicants' independent claims, and (2) the Guski patent, used in rejected each of Applicants' independent claims, is an improper reference under 35 U.S.C. § 103(c). Either of the above two reasons overcomes all of the rejections of Applicants' independent claims.

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The remaining dependent claims each depend, directly or indirectly, on an allowable independent claim, as described above. Therefore, each of the remaining dependent claims is allowable for at least the same reasons that the independent claims are allowable.

Conclusion

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and Applicants respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner contact the Applicants' attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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